UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,805	09/26/2000	Scott C. Harris	RTA/SCH	3717

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ART UNIT	PAPER NUMBER
3679	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/669,805	HARRIS, SCOTT C.
	Examiner	**Art Unit**
	Ryan M Flandro	3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 September 2004*.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,5,7,13-26,28 and 29* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,5,7,13-26,28 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 May 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some *　c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 9/3/04 has been entered.

Terminal Disclaimer

3.   The Terminal Disclaimer submitted 9/3/04 is not proper because the number of the

application to which is pertains (i.e., the instant application) has not been identified.

Accordingly, the Terminal Disclaimer has been **disapproved**.

Drawings

4.   New drawings were received on 5/3/04. These drawings are unacceptable (please see

information on how to effect drawing changes set forth below). New corrected drawings are

required in this application. The corrected drawings are required in reply to the Office action to

avoid abandonment of the application. The requirement for corrected drawings will not be held

in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. *Any replacement drawing sheet __must__ be identified in the top margin as "Replacement Sheet"* (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Objections

5.   Claim 7 is objected to because line 4 includes a typo – the phrase "in a-manner" should

be --in a manner--.

Claim Rejections - 35 USC § 112

6.   In view of Applicant's Amendment to claim 7, the previous rejection of this claim under

35 USC §112, second paragraph, has been overcome.

Claim Rejections - 35 USC § 103

7.   Claims 2, 22, 25, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over eBay[1] in view of Odom.

>   a. Claim 2 and 22. eBay discloses each and every limitation recited in claim 2,
>
>   including storing information about an amount that will be required to overcome any
>
>   current bids on the item, which information is indicative of the amount that will be
>
>   required to overcome any current bids cannot be viewed by a user of the second computer
>
>   and which information allows determination of whether an entered bid is higher than a
>
>   current bid amount. eBay does not, however, teach or disclose that said information is
>
>   stored at the second computer or that the information allows local determination without
>
>   contacting said first computer. In eBay the information is stored on the central server and
>
>   determinations are made once a bid is submitted thereto.
>
>   Nevertheless, Odom teaches storing information on the second computer about an
>
>   amount that will be required to overcome any current bids on the item, which information
>
>   is indicative of the amount that will be required to overcome any current bids and which
>
>   information allows local determination at the second computer of whether an entered bid
>
>   is higher than a current bid amount without contacting said first computer (see column 6

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[1] http://pages.ebay.com/aw/proxy-bidding.html, viewed February 1999.

lines 28-58 and *especially* lines 31-45). Odom teaches this system such that

"unnecessary communications to the server are avoided."

Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to store the aforementioned information on the second

computer so that local determinations can be made as to the submitted bid to avoid

unnecessary communications with the central server as taught by Odom.

b.   Claim 25. eBay discloses each and every limitation recited in claim 25, including on

a first computer connected to the internet hosting an internet auction for an item;

accepting bids on said at least one item from at least one other computer, connected to

said first computer, and displaying a current price for the item on said other computer,

and keeping secret a current maximum bid which has been placed for the item from a

user of said other computer ("...secret, so no one will know what you maximum bid

amount was"). eBay further uses an Internet browser application on the user end in

conjunction with software on the server to enable automatic bidding, but does not

explicitly disclose displaying an icon on said other computer which allows a bid to be

placed without contacting said first computer, wherein said icon enables placing a bid

which is high enough to exceed said current maximum bid.

Odom, however, teaches displaying an icon on said other computer 170 (column 8

lines 30-33 – second computer employs a GUI, which is defined as an interface for

issuing commands to a computer utilizing a pointing device, as a mouse, that manipulates

and activates graphical images --icons-- on a monitor.[2]) which allows a bid to be placed without contacting said first computer **100** wherein said icon enables placing a bid which is high enough to exceed a current maximum bid (see column 6 lines 28-55 and *especially* lines 31-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to manually click an icon that will allow a user to bid an amount that exceeds a current maximum bid without contacting said first computer to avoid unnecessary communications with the server and to allow a user to outbid a current maximum amount. Given the teachings of Odom, the bidder in the eBay example could simply click the icon to bid $8.50 (although the user would not know this amount until after the bid was placed) to outbid Joe's maximum of $8.00.

c. Claim 26. The combination of eBay and Odom further discloses running an applet (a local application) on said second computer, which includes information enabling determining whether an entered bid is higher than said maximum bid (see column 6 lines 28-55 and *especially* lines 31-45).

d. Claim 28. The combination of eBay and Odom further includes, in said second computer, determining whether an entered bid is higher than said secret maximum bid amount, and informing a user at said second computer without contacting said first computer (see Odom column 6 lines 28-55 and *especially* lines 31-45).

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[2]*The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

8.　Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over eBay and Odom, as

applied above, in view of Ausubel (US 5,905,975).　The combination of eBay and Odom lacks

explicit disclosure that said bids include an indication of time and date, and said placing

comprises providing bids to an agent program which keeps that amounts of the bids secret until a

time of day and date specified by the bid.

　　　　Ausubel, however, teaches a method wherein said bids are provided to an agent program

(see top of column 3 – "intelligent systems…auctioneer's system"), which keeps the amounts of

the bids secret (see column 1 lines 63-64 *"combining some of the advantageous facets of the*

sealed-bid format…") until a time that is specified by the bid (see generally column 2).　This

allows users to create a set of rules (which could include bids being placed at specific times) that

take place during the auction without action of the user so that the user need not monitor the

auction throughout its duration.　Furthermore, such rules are not known to other users and are,

therefore, secret.

　　　　Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to provide bids to an agent program which keeps that amounts of the

bids secret until a time specified by the bid in order to allow the user to avoid having to

constantly monitor the auction as taught by Ausubel.

9.　Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over eBay in view

of Brown (5,794,219).

　　　　a.　　　Clearly, eBay discloses on a computer connected to the Internet, hosting an

　　　　auction in a mode where users view an item, and a price for an item, in a manner in

which users can place bids on items, and in which a current highest bid can be requested by another computer connected to the Internet; and hosting the auction in an interactive manner, in which the auction participants place real-time bids.

With regard to the recitation of first and second portions of the auction, the Examiner specifically notes that the instant claim uses the preamble transition "comprising". As this is considered an open transition, the claim allows an interpretation wherein the entire auction is essentially practiced under one model, such as that described in eBay. That is, because the traditional eBay auction model teaches every limitation recited in the claim throughout a given auction, each limitation recited as being part of "a second portion" can be present in "a first portion", and vice versa.

eBay does not explicitly disclose that the real time bids are seen automatically by other participants in the auction. Nevertheless, Brown teaches a system wherein a server automatically updates at least one screen being seen on at least one client to automatically show new bid amounts (*See* figures 2 and 9; column 6 line 53 – column 8 line 18; *see specifically* column 8 lines 12-18 – "Specific techniques of updating browser **29** in this manner are well known in the art."). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the feature wherein the server automatically updates the bid amounts shown on at least one screen being seen on at least one client so that each client display is consistent with the current auction situation as taught by Brown.

b.   Claim 24. Under the same rationale provided above, eBay further includes displaying information on client bidders who are currently bidding on the auction.

10. Claims 7, 23 and 24 are also rejected under 35 U.S.C. 103(a) as being unpatentable over

Odom in view of Alaia et al (US 6,199,050) (Alaia).

  a. Claim 7. Odom clearly discloses a method of conducting an auction on the internet

comprising on a computer **100** connected to the internet, first hosting a first portion of the

auction in a mode where users view an item, and a price for the item (figure 2 – steps

210,215; see column 5 line 45 – column 6 line 27), and in which users can place bids on

the items and users can request a current highest bid (see column 6 lines 28-32), as well

as second hosting a second portion of the auction in an interactive manner, in which the

auction participants place real time bids, which real time bids are seen automatically by

other participants in the auction (see column 6 lines 55-58). Importantly, with regard to

the recitation of first and second portions of the auction, the Examiner specifically notes

that the instant claim uses the preamble transition "comprising". As this is considered an

open transition, the claim allows an interpretation wherein the entire auction is essentially

practiced under one model, such as that described in Odom. That is, because the Odom

auction model teaches every limitation recited in the claim throughout a given auction,

each limitation recited as being part of "a second portion" can be present in "a first

portion", and vice versa.

  In any event, assuming the claim required distinct first and second portions

having different functionality, Alaia further teaches (see column 20 line 63 – column 22

line 51) that auctions are known have a first mode in which users place sealed bids on

items (see column 22 lines 34-35) followed by a second on-line portion in which bidders

interactively submit bids in real time in order for the seller (or the buyer, depending on

the nature of the auction) to allow bidder specific bid limitations to help achieve the

optimal outcome for the seller (see column 24 lines 56-60). Therefore, it would have

obvious to one having ordinary skill in the art at the time the invention was made to allow

bidding during a first portion of an auction in order to more effectively achieve an

optimal outcome as taught by Alaia.

b. Claim 23. The combination of Odom and Alaia set forth above includes the fact that

users cannot view information about other bidders in the auction during said first portion

of the auction (see Alaia column 20 line 63 – column 22 line 51 – pre-bids are sealed

such that the other suppliers cannot view individual bid ceilings), but can view

information about other bidders on the auction during said second part of the auction (see

e.g. Alaia figure 8). This "information" may simply include the current real-time bids of

the other bidders.

c. Claim 24. Alaia further teaches that said second portion comprises displaying

information on client bidders who are currently bidding on the auction (see figure 8).

11. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over eBay in view of

Ausubel and Hartman et al (US 5,960,411) (Hartman).

a. Claim 13. eBay discloses a method of automated auction bidding, comprising on a

first computer connected to the internet, hosting an auction which allows a plurality of

users at remote locations, that are remote from a location of said first computer, to bid on

an item, where one of the plurality of users (e.g. "Joe" in the eBay example) has a highest

bid which represents a maximum amount that the one user is willing to pay, and at least

one other of the plurality of users (e.g., "You" in the eBay example) can bid an amount

that exceeds said highest bid; said first computer displaying a current winning amount,

which is an amount that exceeds all the other bids on the item, but which my be less than,

or the same as, said highest bid, depending on the relationship between said highest bid·

and said all other bids, and said first computer not displaying said highest bid (i.e., Joe's

maximum bid), and not displaying a minimum bid amount that will be required to exceed

said highest bid.

eBay lacks explicit disclosure of enabling a quick bid whereby a user can

automatically bid an amount which will exceed the highest bid.

Ausubel, however, teaches enabling a quick bid whereby a user can automatically

bid an amount which will exceed the highest bid (see column 1 line 61 – column 3 line

67; see also example at column 10 line 39 – column 12 line 19 - in the example, the

automated system containing bidder 1's bidding rules automatically places bids high

enough to win current bidding situations depending on the particular auction

circumstances). Ausubel further discloses that the user may actively participate rather

than rely on previously set bidding rules and would thereby be able to manually submit

bids.

Still, however, neither one of eBay or Ausubel teaches or discloses that said quick

bid is submitted via a <u>single click</u>. Nevertheless, Hartman teaches that single click order

placing is well known in the art (see e.g. column 2 lines 55-60 and column 3 lines 30-67).

Hartman employs the single click action within the context of placing an order over a

communications network which is analogous to, if not exactly the same as, submitting a

quick bid over the internet in the context of an auction settting. The single click action of

Hartman is made possible by way of previous entry of user identification information and

assignment of a unique identifier to that user so that future submissions require only

minimal effort (i.e. a single click) and prevent redundant transmission of sensitive

information over the network.

Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to include the ability to submit a quick bid via the action of

a single click as taught by Hartman.

b. Claim 14. Both eBay and Ausubel further disclose and/or teach a plurality of bids,

some of which are known and others of which are secret, and wherein said quick bid only

overcomes those bids which are known (see eBay in general and Ausubel column 1 line

61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19).

c. Claim 15. Ausubel further teaches said plurality of bids includes a plurality of bids,

associated with times when those maximum bids can be made, and only those bids whose

times have been reached are known (see column 1 line 61 – column 3 line 67; see also

example at column 10 line 39 – column 12 line 19).

d. Claim 16. Ausubel further teaches enabling an action which allows determining both

secret bids and non secret bids (see column 1 line 61 – column 3 line 67; see also

example at column 10 line 39 – column 12 line 19 – in the example, the automated

system performs queries which determine both secret and non-secret bids according to

the rule profile).

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of

eBay, Ausubel and Hartman, as applied above, further in view of Woolston (US 6,202,051).

Ausubel lacks explicit disclosure that said action includes an extra fee beyond that which would

be charged for only non secret bids. Woolston, however, teaches that it is well known in the art

to include fees charged for various actions in the auction setting (see specifically claims 29 and

30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to include an extra fee beyond that which would be charged for only non-

secret bids since it is well known in online auctions to charge for various actions associated with

an auction as taught by Woolston.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Odom, further in

view of Hartman. Odom discloses a system comprising a server **100** running a program that

displays information about an item to be auctioned (see column 6 lines 5-10), and accepts bids

on said item (see column 6 lines 28-58), and keeps track of a maximum bid (column 6 lines 48-

53); and a client **170** enabling and sending a bid to said server **100** which includes an amount of

a bid (see column 6 lines 28-58 and element 220 of figure 2). Odom does not explicitly disclose

that the client sends the bid to said server with a single click. Nevertheless, Hartman teaches that

single click order placing is well known in the art (see e.g. column 2 lines 55-60 and column 3

lines 30-67). Hartman employs the single click action within the context of placing an order

over a communications network which is analogous to, if not exactly the same as, submitting a

bid over the internet in the context of an auction settting. The single click action of Hartman is

made possible by way of previous entry of user identification information and assignment of a

unique identifier to that user so that future submissions require only minimal effort (i.e. a single

click) and prevent redundant transmission of sensitive information over the network. Therefore,

it would have been obvious to one having ordinary skill in the art at the time the invention was

made to include the ability to submit a bid via the action of a single click as taught by Hartman.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of·

Odom and Hartman, as applied to claim 18 above, further in view of Brown, as applied above.

The combination of Odom and Hartman lacks explicit disclosure of a system wherein said server

automatically updates at least one screen being seen on at least one client to automatically show

new bid amounts. Brown, however, clearly teaches a system wherein said server automatically

updates at least one screen being seen on at least one client to automatically show new bid

amounts (*See* figures 2 and 9; column 6 line 53 – column 8 line 18; *see specifically* column 8

lines 12-18 – "Specific techniques of updating browser **29** in this manner are well known in the

art."). Therefore, it would have been obvious to one having ordinary skill in the art at the time·

the invention was made to include the feature wherein the server automatically updates the bid

amounts shown on at least one screen being seen on at least one client so that the client is

consistent with the current auction situation as taught by Brown.

15. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over eBay and Odom,

further in view of Hartman. The combination of eBay and Odom, as applied to claim 25 above,

does not explicitly include that the client sends the bid to said server with a single click.

Nevertheless, Hartman teaches that single click order placing is well known in the art (see e.g.·

column 2 lines 55-60 and column 3 lines 30-67). Hartman employs the single click action within

the context of placing an order over a communications network which is analogous to, if not

exactly the same as, submitting a bid over the internet in the context of an auction settting. The

single click action of Hartman is made possible by way of previous entry of user identification

information and assignment of a unique identifier to that user so that future submissions require

only minimal effort (i.e. a single click) and prevent redundant transmission of sensitive

information over the network. Therefore, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to include the ability to submit a bid via the

action of a single click as taught by Hartman in order to speed up the process of placing bids.

16. Claims 18, 20 and 21 are also rejected under 35 U.S.C. 103(a) as being unpatentable over

Ausubel in view of Hartman.

> a. Claim 18. Ausubel discloses a system comprising a server running a program that
>
> displays information about an item to be auctioned and accepts bids on said item and
>
> keeps track of a maximum bid; and a client enabling and sending a bid to said server
>
> which includes an amount of a bid (see column 1 line 61 – column 3 line 67). Ausubel
>
> does not explicitly disclose that the client sends the bid to said server with a single click.
>
> Nevertheless, Hartman teaches that single click order placing is well known in the art
>
> (see e.g. column 2 lines 55-60 and column 3 lines 30-67). Hartman employs the single
>
> click action within the context of placing an order over a communications network which
>
> is analogous to, if not exactly the same as, submitting a bid over the internet in the
>
> context of an auction settting. The single click action of Hartman is made possible by

way of previous entry of user identification information and assignment of a unique

identifier to that user so that future submissions require only minimal effort (i.e. a single

click) and prevent redundant transmission of sensitive information over the network.

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to include the ability to submit a bid via the action of a single

click as taught by Hartman. See also *Response to Arguments* section below.

b.   Claim 20. Ausubel discloses a system wherein said client allows sending a plurality

of bids, to be executed at a plurality of times (see column 1 line 61 – column 3 line 67).

c.   Claim 21. Ausubel further discloses an amount of said quick bid being displayed

responsive to a specified action by the user (e.g., inputting the bid on the bid sheet

displayed on user's system) (see column 1 line 61 – column 3 line 67).

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this

application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37

CFR 3.73(b).

18. Claims 2 and 22 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claim 10 of copending

Application No. 09/780,248. Although the conflicting claims are not identical, they are not

patentably distinct from each other because they recite substantially similar subject matter. Both

claims recite bid validity determination at the local computer without contacting the computer

hosting the auction. Claim 10 of the '248 application merely includes additional auction

limitations which are considered to be old in the art, such as specific recitation of sending

information between a server to a local computer. Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to include the limitations

regarding bid validity determination at the local computer without contacting the computer

hosting the auction as recited in claim 10 of the '248 application.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

19. Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claim 10 of copending Application No. 09/780,248

in view of claim 8 of the '248 application. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially similar subject matter. Claim 10 of the copending application, as applied above, includes local determination of bid validity as recited in instant claim 2, but lacks recitation of time-specific bid rules. Claim 8 of the '248 application, however, also recites user defined bid rules in an auction that are kept secret until a specified time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to recite time-specific bidder rules that remain secret until the defined time.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. Claims 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 10-13 and 21 of copending Application No. 09/780,248, in view of Hartman and Brown. Claims 5, 10-13, and 21 of the '248 application recite the subject matter which is claimed in claims 18-20 of the instant application including displaying an item (see claim 12), allowing bids (see claim 12), keeping track of a maximum bid (claim 10), automatically updating client displays (see claim 11), and including time-dependent bid rules (claim 5). Claims 5, 10-13 and 21 do not, however, recite single click bid placement. Hartman, however, teaches that it is well known in the art to include a single click function for transmitting information over a network in order to simplify such process. Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to include single click functionality within the context of an auction

based on the teachings of Hartman.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

21. Applicant's arguments are addressed to the claims *as amended* and are unpersuasive.

22. Applicant's arguments with respect to claims 2 and 25 have been considered but are moot in

view of the new ground(s) of rejection which include eBay. The arguments are addressed in the

detailed rejections set forth above.

23. In response to Applicant's arguments regarding claim 5, the Examiner notes that Ausubel

teaches that bidding rules may vary widely depending on the instant bidder's preferences such

that the details of each rule-controlled bid are kept secret until the parameters of the rule are met.

The recited time-dependent placement of bids is believed to fall within the wide range of bidding

rules taught by Ausubel.

24. In response to applicant's argument against the rejections of claims 7, 23 and 24, that Alaia

and Odom are not properly combinable to teach the claimed limitations because Alaia teaches "a

very different kind of auction", the Examiner respectfully disagrees. The test for obviousness is

not whether the features of a secondary reference may be bodily incorporated into the structure

of the primary reference; nor is it that the claimed invention must be expressly suggested in any

one or all of the references. Rather, the test is what *the combined teachings of the references*

would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981). Here, given the open language of the claim ("comprising"), the

auction model of Odom can be construed to read on an auction having two portions as described

above. Furthermore, the teachings of Alaia suggest the advantages of conducting an auction in

two parts wherein pre-bids can be submitted on an item in one portion and then real-time bids are

taken later in an on-line portion to increase bid competition for the seller. The rejection is

accordingly maintained.

25. In response to Applicant's arguments regarding claim 13 and its dependents, specifically that

Hartman is not properly combined with Ausubel (and now eBay), the Examiner notes that one

cannot show nonobviousness by attacking references individually where the rejections are based

on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In*

re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, eBay and Ausubel teach

that a remote user in an auction can automatically bid an amount that exceeds the highest bid of

another user after viewing a current winning amount and without seeing the highest bid. The

combination of eBay and Ausubel includes such bid being placed automatically based on a proxy

bid and, thus, only lacks that the bid is placed by a single click. There, the highest bid amount is

at least known by the auction system and, in this respect, is considered similar to a set price in

any online purchase. One of ordinary skill in the art, in view of Hartman, would recognize that

an auction winning quick bid would be placed with a single click to outbid the known highest bid

amount. In view of the foregoing, the Examiner maintains the above rejections.

Conclusion

26.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The

examiner can normally be reached on 9:00am- 6:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMF
November 29, 2004

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